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ANAKKU BABY PRODUCTS SDN. BHD.

v.

COMELKU BABY PRODUCTS SDN. BHD. & ANOR.

*b*HIGH COURT MALAYA, KUALA LUMPUR
ABDUL MALEK AHMAD J
[CIVIL SUIT NO. D5-22-485-90]
16 JULY 1992

TRADEMARKS: *Whether defendant had infringed plaintiff's trademark - Non-disclosure of material fact of priority - Whether agreement had been reached - Passing-off.*

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On 21 March 1990, the plaintiff obtained an *ex parte* order against the defendants restraining them from infringing the trademark of the plaintiff. Plaintiff had also obtained an order restraining the defendant from passing-off baby apparel and other related products which bears the trade mark of the plaintiff or is similar, confusingly and or deceptively similar to plaintiff's trademark. The main issues were whether the defendant had infringed the plaintiff's trademark "Anakku" by using "Comelku" for their baby apparel products which are similar to that of the plaintiffs and whether there had been any agreement between the parties before the Court hearing of the matter. On 8 December 1990, the defendants *inter alia* applied to set aside the *ex parte* order of the plaintiff.

*d***Held:**

[1] Injunction ought to be set aside on the grounds of non-disclosure of the material fact of priority in respect of the application for registration alone.

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[2] The two marks are definitely different in wording, meaning, get-up, appearance, pronunciation and colour and were therefore not identical nor so nearly resembling one another to deceive or to cause confusion.

[3] As to the contention whether there had been any agreement reached between the parties before the hearing, the Court held that it was an issue for trial.

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[4] On the above factors, the injunction was set aside with costs and the learned Senior Assistant Registrar to assess the damages, if any, sustained by the injunction.

[Injunction set aside with costs. Senior Assistant Registrar to assess damages, if any.]

[Editorial Note: The plaintiff has appealed to the Supreme Court *vide* Supreme Court Appeal No. 02-272-1992.]

*g***Cases referred to:**

Tohtonku Sdn. Bhd. v. Superace (M) Sdn. Bhd. [1992] 1 CLJ (Rep) 344 (**fol**)

Hille International Ltd. v. Tiong Hin Engineering Pte. Ltd. [1983] CLJ (Rep) 1002 (**fol**)

Jordache Enterprises Inc. v. Millennium Pte. Ltd. [1985] 1 MLJ 281 (**cit**)

Chong Fok Shang & Anor. v. Lily Handycraft & Anor. [1989] 1 CLJ (Rep) 424 (**not fol**)

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For the plaintiff/respondent - Karen Abraham (S.S. Sie with her); M/s. Shearn Delamore & Co.
For the defendant/applicant - Saran Singh; M/s. Saran Singh & Co.

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JUDGMENT

Abdul Malek Ahmad J:

On 21 March 1990, upon the usual undertaking for damages and upon undertaking to file the statement of claim forthwith, the plaintiff had obtained the following *ex parte* orders:

It is ordered and directed that:

- (1) The defendants jointly and/or severally whether by themselves, their directors, servants, agents and/or licences or any of them or otherwise howsoever be restrained from doing the following acts or any of them that is to say:

- (a) infringing the plaintiffs' Malaysian registered trademark M/68272 and M/76686 by the sales and distribution of baby apparel and other related products of a similar related description bearing the trademark as is more particularly represented in Annexure B or any other trademark and/or get-up which is similar, confusingly and/or deceptively similar to the trademark of the plaintiffs represented in Annexure A.
- (b) passing-off baby apparel and other related products of a similar description not the corresponding products of the plaintiffs' by the use or connection therewith of baby apparel and related products bearing a trademark and/or get-up as is more particularly represented in Annexure B or any other trademark and/or get-up which is similar, confusingly and/or deceptively similar to the trademark and/or get-up of the plaintiffs represented in Annexure A.
- (c) causing, enabling or assisting any others to do or attempt to do any of the offending acts referred to in prayers 1 (a) or (b) above.

- (2) The defendants jointly and/or severally whether by themselves, their directors, servants, agents, licences or any other person(s) appearing to have charge or control of the 1st defendants' or other premises in which the infringing and offending products are stored as are identified in para. (3) herein or any of them do forthwith deliver and surrender up to a solicitor from the firm of Shearn Delamore & Co. of No. 2 Benteng, 50050 Kuala Lumpur, solicitors for the plaintiffs and authorised representatives of the plaintiffs or persons authorised to serve this order of Court for preservation all offending and infringing baby apparel and other related products of a similar description together with all offending packaging materials, labels, cartons, invoices, bills, delivery orders and receipts, used in connection with the 1st defendants' trade and business relating to the said infringing and offending products and do permit the plaintiffs' solicitors and authorised representatives to inspect and photograph all stocks of the said offending and infringing products and to take copies of all documents of relevance.

- (3) That the defendants jointly and/or severally whether by themselves, their directors, servants, agents and/or licences or any of them or the person(s) appearing to be in charge of the premises at:

- (i) 21, Jalan Perusahaan, Seri Kembangan Light Industrial Estate, Seri Kembangan.
- (ii) No. 5 Lorong Brunei 3, Off Jalan Pudu, Kuala Lumpur.
- (iii) 147-1 Bangunan Indah UPC, Batu 3 1/2 Jalan Kelang Lama.

whether such premises belong to the 1st defendants, their directors, servants, and/or licences do forthwith disclose to the person serving the order of Court to be granted hereafter:

- (a) the whereabouts of all the infringing and offending products whether at the said location(s) or elsewhere or being held on the defendants' behalf by any other person(s) and identifying such other person(s);

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- a** (b) the name and addresses of all persons, firms and/or companies whether local or foreign from whom the 1st defendants obtained their supplies of the infringing and offending products and do further within seven (7) days from the date of service of the order to be granted hereafter file an affidavit confirming compliance of the requirements herein and exhibiting to the said affidavit all relevant contracts, documents, invoices, order forms, delivery orders, and all other documents or copies thereof.
- b** (4) That the defendants jointly and/or severally whether by themselves, their directors, servants, agents and/or licences or the person(s) appearing to have charge over the defendants' premises at the locations identified in para. (3) herein do permit the plaintiffs' said solicitors and such other persons not exceeding 3 in number as may be duly authorised by the plaintiffs' solicitors with or without the Court Bailiff to enter and remain upon each of the premises at the location identified in para. (3) herein or such part thereof
- c** including any outhouses as may be occupied or used for the purposes of storage, sales or offer for sales of the infringing and offending products on any day (to include Saturday and Sunday) at any hour between 8 o'clock in the morning and 6 o'clock in the evening for the purposes of:
- d** (a) taking into possession and removing therefrom into the possession and custody of the plaintiffs' said solicitors, pending trial all infringing and offending products including any offending get-ups and packagings as well as other materials and documents that shall have been delivered up or surrendered as required by para. (2) herein.
- (b) carrying out any necessary inspection or photographing permitted by the requirements under para. (2) herein.
- e** (5) The 2nd defendant be restrained from disclosing, divulging, making use or otherwise dealing with any confidential information acquired by him during the course of his employment by the plaintiffs or from any person who acquired such information in the course of his said employment relating to the detailed particulars of the names and addresses of customers who are in trade or business with the plaintiffs.
- (6) That the defendants be at liberty to move this Honourable Court to vary or discharge this Order upon giving notice in writing to the plaintiffs' solicitors of their intention to do so.
- f** and other consequential orders.
- On 8 December 1990, the defendants applied for the following orders:
- g** (a) the Ex Parte Order of Court dated 21 March 1990 be set aside and/or rescinded and/or discharged;
- (b) all items, goods and/or documents seized under the said Order be returned to the first and second defendants forthwith;
- (c) an enquiry by the Senior Assistant Registrar as to damages;
- (d) costs;
- h** (e) any further or other relief as this Honourable Court deems just and proper.
- Despite the thickness of the bundles of files pertaining to this case and the length of the plaintiff's prayers and consequently the orders obtained, there are in fact only two issues to be decided here and they can be considered quite briefly.
- The first is whether the defendants had infringed the plaintiff's trademark "Anakku" by using "Comelku" for their products which are similar to that of the plaintiff's namely baby apparel.
- i** It is relevant to note at this point that the plaintiff had applied, in order to expand their

market, to register a number of other marks namely “Bayiku”, “Bayimu”, “Anakmu”, “Sicomel” and “Comelku” on various dates from 27 December 1989 to 6 March 1990, whereas the defendants had applied for registration of “COMELKU” on 21 December 1989. All these applications are pending registration. Accordingly, the plaintiff has no priority in respect of the application for registration in the first place for “Comelku”. The plaintiff had also failed to disclose this fact when applying for the *ex parte* injunction despite the 15-page supporting affidavit of its managing director. Case authorities, too numerous to mention, have ruled that once non-disclosure of a material fact occurs, an injunction ought to be set aside without the necessity of further arguments. On that ground alone therefore, the injunction should be set aside.

Nevertheless, it is interesting to observe that even if we were to disregard the fact of non-disclosure of the priority in respect of the application for registration, a look at the marks “Anakku” and “Comelku” will show that they are substantially different and cannot in any way deceive the public. Although there are two babies in both, their positions are different in the two marks. The two babies in the plaintiff’s mark are rolling upside down with the left one wearing yellow panties and the one on the right with red panties. In the defendants’ mark, the two babies are facing one another holding a pinkish red heart in between them and wearing blue panties. The word “Anakku” is in reddish lettering while “Comelku” is in black. The only similarity in the two words is the “ku” at the end but if this was to be the infringing factor, no one can use a trade mark ending with “ku” which would certainly lead to an absurd situation in this country as regards the registration of trade marks.

Quite fortunately for me, just before the hearing of this matter, I had the timely advantage of reading the decision of the Supreme Court in *Tohtonku Sdn. Bhd. v. Superace (M) Sdn. Bhd.* [1992] 1 CLJ (Rep) 344 which had agreed with the trial Judge in the Court below who, as regards the trade marks “Sister” and “Mister”, had said that “it is not likely ordinary purchasers would be deceived into regarding the intervener’s product to be the product of the applicant” and that:

there is no similarity between the two words ‘Mister’ and ‘Sister’ as to be likely to cause deception or confusion. The words are different. There is similarity in the second syllable but as a whole the similarity is not close enough as to be likely to cause deception or confusion. Further, the get-up of the intervener’s product is green background colour with the picture of a lady whereas the get-up of the applicant’s product is white-blue-grey background colour with the picture of a lady and a man.

In coming to their conclusion, the Supreme Court had referred to three relevant authorities. In *Hille International Ltd. v. Tiong Hin Engineering Pte. Ltd.* [1983] CLJ (Rep) 1002 it was ruled that although the defendant had deliberately invented the word “Cilly” for their products to deceive and cause confusion in the trade, there was no passing off with regard to the plaintiff’s “Hille” as the colours and shapes used in the manufacture of their products were common to the trade. Similarly, in *Jordache Enterprises Inc. v. Millennium Pte. Ltd.* [1985] 1 MLJ 281 the Court had held that looking at and listening to the two names “Jordache” and “Jordane” it had ineluctably arrived at the conclusion that one so closely resembled the other as to be likely to deceive or cause confusion in the course of trade but despite the infringement, the plaintiffs had failed to establish their claim for passing off.

Finally, in *Chong Fok Shang & Anor. v. Lily Handycraft & Anor.* [1989] 1 CLJ (Rep) 424, the finding of the Court was that judging from the sound and appearance of the two words “Minlon” and “Winlon”, the latter so nearly resembled the former as to be likely to deceive or cause confusion. It is interesting to note that this case was decided by the same trial

- a* Judge who had heard the dispute between “Mister” and “Sister” but who had come to a different decision based on the differences in the get-ups although basically the words involved in both cases were only different as regards the first letter. To my mind, the similarity of the words in *Tohtonku’s* case is so much stronger than here as only the first letter is different and the pronunciation is almost the same there whereas entirely different words “Anak” and “Comel” are used here. Accordingly, following the principles enunciated in
- b* *Tohtonku’s* case and the reasons stated earlier, my view is that the two marks here are quite different and there cannot arise any confusion.

Of course what is upsetting the plaintiff, as stated in their affidavits, is the fact that the second defendant was once their marketing director who had resigned from their employment on 14 November 1989. However, apart from considering my ruling as regards the differences in the marks, this should not be a factor in continuing with the injunction.

- c* The second issue is whether there had been any agreement reached between the parties before the hearing of the matter and although learned Counsel for the defendants had objected to the production of the letters without prejudice as regards the alleged settlement, whether or not an agreement had been reached is to my mind an issue to be tried since although the letters show that some attempt had been made to settle the matter, the prepared agreement
- d* had never in fact been signed.

To recapitulate, the injunction ought to be set aside on the grounds of non-disclosure of the material fact of priority in respect of the application for registration alone. Assuming I am in error on that point, my considered opinion is that the two marks are definitely different in wording, meaning, get-up, appearance, pronunciation and colour and are therefore not identical nor so nearly resembling one another to deceive or to cause confusion.

e Consequently, since whether the agreement negotiated between the parties had been reached is an issue for trial, my view was that, on these considerations, the injunction ought to be set aside with costs and the learned Senior Assistant Registrar is to assess damages, if any, sustained by the injunction.

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Also found at [1992] 4 CLJ 1829

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